

**BAKER BOTTS** LLP.

Attorney Docket N . AP33357-072396.0217

REMARKS

This paper is being submitted in response to the Office Action dated March 11, 2003 and in response to the telephonic interview with the Examiner and Christopher Lowe on April 16, 2003. Claims 1-27 are pending.

I. Claim rejections under 35 U.S.C. § 112, second paragraph:

The Examiner has rejected claims 1-27 under 35 U.S.C. § 112, second paragraph as indefinite. The Examiner alleges that the term "having" in claim 1 is indefinite because it is open-ended, and has suggested the use of the closed term "consisting essentially of". Applicants wish to point out that during the telephonic interview on April 16, 2003, Christopher Lowe indicated that this rejection would be reconsidered. Applicants pointed out during the telephonic interview that the peptides of claim 1 are all novel and that no art was cited against the peptides, therefore the use of the term "having" does not read on any full length proteins. Furthermore, Applicants pointed out that the specification clearly teaches that the peptides of the present invention may include additional amino acid sequences, including that of a full length protein (e.g., the amino acid sequence of a cargo, such as lysozyme, is linked to the peptides of claim 1). See page 25-26, paragraph 65 of the present application. As such, the use of the term "having" is fully supported by the specification and is definite in light of the specification. Therefore, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. § 112, second paragraph be withdrawn.

The Examiner has also rejected claim 18 as indefinite for reciting the phrase "at least one cysteine," alleging that it is unclear as to whether or not unrecited cysteine or cysteine-containing fragments additionally attach to the peptides, because all of the peptides of claim 1, from which

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18 depends, do not contain a plurality of cysteine residues. The Examiner further contends that because the "having" language is indefinite and that Claim 1 should not be open ended, there can not be a plurality of cysteines in the peptides of Claim 1. During the telephonic interview, Christopher Lowe indicated that the rejection of Claim 1 would be reconsidered. In addition, as provided above, Applicants believe that the arguments presented herein should result in a withdrawal of the rejection of claim 1 as indefinite for the use of the term "having." Therefore, Applicants assert that Claim 18 is definite because the peptides of claim 1 can comprise other amino acids, including additional cysteine residues. Therefore, Applicants respectfully request that the rejection of claim 18 under 35 U.S.C. § 112, second paragraph be withdrawn.

II. Claim rejections under obviousness type double patenting

The Examiner has provisionally rejected claims 1-27 for obviousness type double patenting, alleging that the claims conflict with claims 2-7, 25-28, 35, 38-40, 54-55 and 62 of applicants co-pending Application Serial No. 10/079,075. Applicants respectfully disagree and point out that the claims of Application serial no. 10/079,075 do not contain any overlapping subject matter. The Examiner alleges that (1) claims 2-7 of Application 10/079,075 disclose common subject matter of claims 1 and 2 of the present application, despite different scope; (2) claims 2-7 of Application 10/079,075 disclose the same subject matter of claims 3-8 of the current application; (3) claims 25, 27 and 28 of Application 10/079,075 disclose the common subject matter of claims 9, 10 and 11 of the present application; (4) claim 35 of Application 10/079,075 is an obvious variation over claims 12-17 and 26 of the present application because the disclosure of Application 10/079,075 sets forth that "the peptides of the present invention are useful as coatings on implanted devices" and also refers to SEQ ID NO:2 of the present claims as

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an antimicrobial peptide, (5) claims 38 and 39 of Application 10/079,075 disclose the common subject matter of claims 18-19 of the present application, (6) claim 40 of Application 10/079,075 is an obvious variation over claims 20-21 because the disclosure of 10/079,075 sets forth that the invention is directed to peptide-cargo complexes which comprise the peptides of the claims of the present application; (7) claim 40 of Application 10/079,075 is an obvious variation over claims 22 and 24 of the present application because Application 10/079,075 discloses a method for inhibiting microbial growth by administering a peptide of SEQ ID NO:2 of the claims of the present application; (8) claim 54 of Application 10/079,075 is an obvious variation over claims 23-24 of the present application because Application 10/079,075 discloses a method for inhibiting microbial growth in a cell by contacting the cell with the peptides of the claims of the present application; (9) claim 62 of Application 10/079,075 is an obvious variation over claim 27 of the present application because Application 10/079,075 sets forth that the antimicrobial peptides of the claims of the present application are active against antibiotic resistant microbes; and (10) claim 55 of Application 10/079,075 is an obvious variation of claim 25 of the present application because Application 10/079,075 sets forth that the antimicrobial peptides of the claims of the present application can be administered enterally or parenterally.

Applicants respectfully disagree. Applicants point out that the MPEP, section 804, paragraph II(b)(1) indicates that

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is – does any claim in the application define an invention that is merely an obvious variation of an invention **claimed** in the patent [or copending application]? . . . Obviousness-type double patenting requires rejection of an application claim when the **claimed** subject matter is **not patentably distinct** from the subject matter **claimed** in a commonly owned patent when the issuance of second patent would provide unjustified extension of the term of the right to exclude granted by a patent.

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*emphasis added.* The analysis relates to the **claims**, not to the specification. Section 804, paragraph II(b)(1) further makes this clear by emphasizing that "when considering whether the invention defined in a **claim** of an application is an obvious variation of the invention defined in the **claim** of a patent [co-pending application], the disclosure of the patent **may not be used as prior art.**" The Examiner seems to believe that because the **specification of co-pending Application 10/079,075** discloses the peptides of the claims of the present application, the **claims** of Application 10/079,075 and those of the present application are an obvious variation of one another. However, the relevant inquiry is not focused on the specification, but rather the **claims**. The peptides of the claims of U.S. Patent Application Serial No. 10/079,075, are different and unique peptides from the peptides claimed in the present application. Therefore, the claims of the present application can not be an obvious variation of the claims of Application 10/079,075, regardless of the subject matter disclosed in the specification of the application. Therefore, Applicants respectfully request that the rejection of claims 1-27 for obviousness type double patenting be withdrawn.

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III. Conclusion

In view of the telephonic interview conducted on April 16, 2003 and the remarks made herein, Applicants respectfully submit that the claims are presently in condition for allowance. Favorable reconsideration of this application is therefore earnestly solicited.

Respectfully submitted,



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